

REMARKS

This amendment is being filed in response to the Office Action having a mailing date of December 20, 2002. This amendment is the required reply that accompanies a Petition for Revival of an Application Abandoned Unintentionally under 37 C.F.R. § 1.137(b). Claims 1-3, 11, 16-23, 25, 28, 30, 33, and 35-41 are amended as shown. More specifically, certain independent claims have been amended to recite distinctive features. New claims 42-48 are added. No new matter has been added. With this amendment, claims 1-48 are pending in the application.

A. Change of Correspondence Address/New Power of Attorney

The applicants have changed attorneys. The appropriate power of attorney documents are enclosed with this amendment. All future correspondence, including the decision on the Petition for Revival, should be directed to Dennis M. de Guzman (Reg. No. 41,702) at the Seed Intellectual Property Law Group (Customer No. 00500) address noted below:

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B. Petition for Revival of Application for Unintentionally Abandoned Application

Form PTO/SB/64 for a Petition for Revival of an Unintentionally Abandoned Application is included along with this amendment. The appropriate petition fee is submitted herewith as well. The Form PTO/SB/64 petition also includes the requisite statement as to the unintentional delay in filing the required reply to the Office Action. Under 37 C.F.R. § 1.137(b), this statement is sufficient to establish the unintentional abandonment of the application. However, if the U.S. Patent Office requires additional information from the applicants, the U.S. Patent Office is encouraged to contact the undersigned attorney so that he can provide the additional information. The applicants respectfully request the U.S. Patent Office to grant their petition.

C. Applicants' Discussion of the Office Action

In the Office Action, the specification was objected to because of various informalities. The specification is amended as shown to address these and other informalities noted by the applicants' attorney.

Claims 18-23 and 28 were rejected under 35 U.S.C. § 112, second paragraph, for being indefinite. More specifically, these claims were rejected for various antecedent basis issues. These claims have been amended to provide proper antecedent basis, and therefore, the rejections under 35 U.S.C. § 112, second paragraph are overcome.

Claims 1-11, 16-19, and 35-40 were rejected under 35 U.S.C. § 102(e) as being anticipated by McNerney (U.S. Patent No. 5,999,208). Claim 12 was rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of McNerney and Liles (U.S. Patent No. 5,880,731). Claims 13-15 and 32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of McNerney in view of Maurer (U.S. Patent No. 6,272,231). Claims 20-22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over McNerney in view of Balma (U.S. Patent No. 6,157,945). Claim 23 was rejected under 35 U.S.C. § 103(a) as being unpatentable over McNerney in view of Weishut (U.S. Patent No. 5,923,737). Claims 24, 30-31, 33-34, and 41 were rejected under 35 U.S.C. § 103(a) as being unpatentable over McNerney in view of Honda (U.S. Patent No. 6,020,885). Finally, claims 25-29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over McNerney in view of Herrick (U.S. Patent No. 5,778,222). For the reasons set forth below, the applicants respectfully disagree with these rejections, and request that the pending claims be allowed.

With regard to the rejections of claims 13-15 and 32 under 35 U.S.C. § 103(a) as being unpatentable over the combination of McNerney in view of Maurer, the applicants request withdrawal of this rejection because Maurer does not qualify as prior art.

The applicants submit that the Maurer patent is not an appropriate reference and seek disqualification of Maurer as prior art against the pending claims 13-15 and 32 in accordance with 35 U.S.C. § 103(c). In particular, 35 U.S.C. § 103(c) states that subject matter developed by another person, which qualifies as prior art only under 35 U.S.C. § 102(e), shall not preclude patentability under this section where the subject matter and the claimed invention

were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. In this regard:

Current Application Serial No. 09/520,479 and U.S. Patent No. 6,272,231(Maurer) were, at the time the invention of current application 09/520,479 was made, owned by or subject to an obligation of assignment to Eyematic Interfaces, Inc.

According to M.P.E.P. § 706.02(l)(2), the above statement is sufficient to disqualify Maurer as prior art. As additional evidence of common ownership, the applicants provide the following data:

For the Maurer patent, an assignment from the inventors to Eyematic Interfaces, Inc. is recorded at the USPTO Assignment Division at Reel 009739, Frame 0290. Eyematic Interfaces, Inc. is also indicated as the assignee on the face of the issued patent.

For current Application Serial No. 09/520,479, an assignment from the inventors to Eyematic Interfaces, Inc. is recorded at Reel 011075, Frame 0030.

Because Maurer does not qualify as prior art, the features of dependent claims 13-15 in combination with original base claim 11 are allowable. Accordingly, new claim 42 has been written along the lines of claims 11 and 13 combined. New independent claim 44 has been written along the lines of claims 11 and 15 combined. Dependent claims have also been provided for these new independent claims. Claim 32 in its current form is allowable over McNerney.

With regards to the rejections of the other claims, a disclosed embodiment will now be discussed in comparison to the applied references. Of course, the discussion of the disclosed embodiment, and the discussion of the differences between the disclosed embodiment and subject matter described in the applied references, do not define the scope or interpretation of any of the claims. Instead, such discussed differences are intended to merely help the Examiner appreciate important claim distinctions discussed thereafter.

One embodiment of the applicants' present invention provides a theater that can be customized by a user, using rich media objects that are placed in the theater by the user. Each user can have their own independent and separate theater, which are not shared with other users. That is, there is the capability to communicate each individual's theater with other individuals.

However, each individual/user can customize their own theater, and these customizations are applied only to that user's theater and not universally to all other users' theaters.

Moreover, another embodiment allows the user to create a personalized three-dimensional avatar representation of a person based on sensed geometrical features of the person. *See, e.g.*, page 10, lines 24-28 of the present application. In an embodiment, the user is also provided with capability to select from different character presentations, one of which includes a three-dimensional avatar. The user can also choose to provide no character presentation at all or to provide an audio presentation. Moreover, during a session in the theater, tools are provided to allow the user to switch immediately between available presentation modes. *See, e.g.*, page 6, lines 4-9 of the present application.

Other features of an embodiment include the capability to select a background setting or scenery that does not necessarily represent a real-life equivalent scene. For example, the user can choose to present a character representation of himself in a mythical "mushroom world" full of giant mushrooms. This is an artistic feature of an embodiment that allows users to use their creativity in the construction of their theater, and does not restrict the user to only real-life scenes. *See, e.g.*, page 5, lines 1-4 of the present application, including Figure 4 where the user can select Saturn as the scene for his theater, which in reality is inhabitable by humans. Embodiments also provide various messaging and directory tools that allow the user to communicate with other users, to communicate rich media content, determine the status of other users, to toggle between a rich media window and a text message before transmission of a rich media message, and other features.

McNerney, in contrast to what the applicants have disclosed, relates to a completely different type of system and method. McNerney relates to a communication system for implementing multiple simultaneous meetings in a virtual conference room. The conference room is shared between the different users. That is, the conference room is provided with various tools that are typically found in real-life conference rooms, such as bulletin boards, notepads, etc. A user wishing to display an item in a bulletin board can drop that media item into the virtual conference room's bulletin board and the result is that all other users will be able to view that dropped media item in their own conference room interfaces.

There are other differences that are to be noted. McNerney discusses use of still or animated two-dimensional images of users. *See, e.g.*, column 5, lines 64-67 through column 6, lines 1-10 of McNerney. There is absolutely no mention of three-dimensional avatars in McNerney. In contrast, with an embodiment of the present application, the user can select a realistic or a non-realistic representation. There need not necessarily be a real-world equivalent representation of the user, and in fact, the user can choose not to have a visual representation at all (*e.g.*, just have an audio representation).

Additional differences include the fact that McNerney is restricted to a real-life equivalent of a conference room. In fact, this is an important aspect of McNerney. As indicated in the Abstract of McNerney, the conference room of McNerney is designed to emulate as closely as possible a real-life conference room, so as to reduce the need for a participant to be trained to operate in the virtual conference room. Various communication devices and other features are emulated in the virtual conference room to be similar to real-life objects, so that the participant need not be skillful users of specific controls or keyboard entries that may otherwise be required to control their participation in a conference.

Independent claim 1 has been amended to recite that a choice of visual presence can include at least a personalized three-dimensional avatar representation of the person based on the sensed geometric features of the person. Independent claims 3, 11, 36, and 40 are also amended to recite selectable three-dimensional avatar representations. As discussed above, this is feature that is not disclosed, taught, or suggested by McNerney. McNerney discloses the use of basic two-dimensional images that can be inserted into a virtual image of a conference room. The use of three-dimensional avatar representations is nowhere to be found in McNerney. Generation and insertion of such images into a theater involves greater technical consideration, which is contrary to the simplified approach of McNerney that attempts to make the user interface as familiar and simple as possible for a non-trained user. In short, McNerney teaches against such a feature. Accordingly, amended claims 1, 3, 11, 36, and 40 are allowable.

Independent claims 2, 36, and 39 are amended to recite the capability to switch between character presentations during a session in the theater or theater window. As described above, this feature is not disclosed, taught, or suggested by McNerney. McNerney involves the

simple insertion of images into chairs of the conference room to represent the participants. McNerney is completely silent as to providing any sort of capability to switch the image of a particular person in the middle of a meeting. In fact, such capability would not be practical or desirable in the system of McNerney. For example, the purpose of the conference meeting is to allow all of the participants to see and become familiar with other participants. Providing the capability to dynamically switch the appearance of any single participant during the meeting would be confusing and distracting to the other participants, since they would be confused as to whether that particular participant has left, been replaced with some other individual, is not participating, etc. Accordingly, independent claims 2, 36, and 39 are now in allowable form.

Independent claim 16 has been amended to recite that the communicator can communicate rich media content for the theater, such as may be used to populate, customize, or otherwise operate the theater. This is also a feature that is not disclosed, taught, or suggested by McNerney. The Examiner has cited item 608 of Figure 4 and column 6, lines 15-19 of McNerney as providing a communicator. However, this communicator of McNerney is only a shared conferencing device that is used to allow users to set up conferences. There is absolutely no notion of using the communicator of McNerney for communicating rich media content, as amended claim 16 now recites. Therefore, amended claim 16 is now allowable over McNerney.

Claim 17 has been amended to recite that the theater is independent of other theaters that include visual representations associated with other persons. Somewhat similar amendments are made to independent claims 25, 30, 37, and 41 to recite the independent nature of each theater as compared to other theaters of other users. As described above, this is a feature of an embodiment where a user can customize his own theater independently, and not have the customization automatically applied to theaters of other users. This is in contrast to the conference room of McNerney, wherein any sort of customization performed by any user is performed on a shared conference room and is viewed by all participants that share the conference room. The amendments to claims 17, 25, 30, 37, and 41 that recite an independent theater distinguish over McNerney, and are now allowable.

Independent claim 24 is not amended. The applicants believe that the recitations in claim 24 already distinguish over the McNerney and Honda references cited by the Examiner.

Specifically, the Examiner has cited Honda as disclosing a status window indicating rich media communications received, the user's visibility to other users, the user's availability to other users, and the user's automatic response to rich media communication messages from other users. A review of Honda indicates that Honda does not disclose all of these recited features. If anything, Honda describes a shared world based on VRML 1.0 graphics. In the shared world of Honda, one can see who else is present in the shared world, but there is no other functionality to provide the other features recited in claim 24, such as the capability to provide a status window indicating the user's automatic response to rich media communication messages from other users. Therefore, claim 24 is allowable.

Claim 31 has also been rejected on the basis of the combination of McNerney and Honda. In particular, the Examiner has cited Figures 21-28 of Honda as disclosing the claimed features, including a rich media window that may be toggled off such that a user may read only the text message before requesting transmission of a rich media message for presentation in the presentation window. A review of Figures 21-28 of Honda shows a text window that is presented concurrently with a rich media window having images and graphics. As clearly seen in these illustrations, the rich media window is not toggled off to allow reading of only the text message. Since this limitation in the claim is not met by Honda, the claim in its current form is allowable over the cited references.

Honda was further used as basis for rejection along with McNerney to reject independent claim 33. Among other things, independent claim 33 recites a content client that includes an authoring tool to generate a rich media communication. To support the rejection, the Examiner has recited Figure 18 and column 20, lines 12-26 of Honda as disclosing a content client that includes an authoring tool. There is no such disclosure, teaching, or motivation to be found in Honda. Figure 18 of Honda simply shows content (such as HTML or VRML files) that is available from a server and viewable through a client browser. The client browser itself has no authoring tool that can modify the content received from the browser. Similarly, column 20, lines 12-26 of Honda simply discusses the capability to provide HTML or VRML files from a server to a client, and does not discuss in any respect the capability of the client browser to

provide or use authoring tools to modify these files. The client browser of Honda is just used to view these files. Therefore, claim 33 is allowable over the cited references.

Claim 35 was rejected on the basis of McNerney. Among other elements, claim 35 recites generating a multiplexed rich media communication bit stream. McNerney does not describe how media streams are multiplexed as claimed. Instead, McNerney talks about the virtual meeting services circuit 28 that contains a number of signal bridging resources that are used to implement conference connections between a plurality of conference participants in one or more selected media. *See, e.g.*, column 4, lines 16-20 of McNerney. This is different from what the applicants have disclosed, wherein multiple media at once (rich media) are multiplexed to create streaming messages or message formats, using a single medium for sending the content, wherein all of the content is placed in a single stream/file. The “multiplexed rich media communication bit stream” (recited in the singular tense, rather than plural tense) highlights the capability to provide multiple media elements on a single stream. McNerney uses dedicated connections for each participant for each media and functionality. As a result, the conferences of McNerney cannot be replayed because of this implementation.

Claim 35 as originally presented is believed to be allowable over McNerney based on the above discussion. However, to facilitate prosecution and to clarify the nature of the multiplexed rich media communication stream, the claim is amended to recite that the bit stream has the media elements. This recitation clarifies that a plurality of media elements are multiplexed on the individual bit stream, which clearly distinguishes over McNerney.

Independent claims 11 and 38 are amended to recite the capability to select a non-real-life-equivalent background presentation scene. This clearly distinguishes over McNerney because McNerney is required to use a virtual conference room that emulates as closely as possible a real-life conference room, so as to minimize the unfamiliarity and required training for conference participants. Claims 11 and 38 are thus allowable. New independent claim 46 recites an independently customizable theater window. As previously described above with regard to other independent claims, this is a feature that is not found in any of the cited references. Accordingly, independent claim 46 is allowable. The claims that dependent on independent claim 46 also recite distinctive subject matter.

The various other references that have been cited in combination with McNerney to reject the various independent claims do not cure the deficiencies of McNerney. That is, the references such as Honda, Herrick, Liles, Balma, Weishut, etc. do not disclose, teach, or suggest features such as independently customizable theater windows, capability to switch between different representations of a person during a session in a theater, non-real-life-equivalent background presentations, three-dimensional avatar representations that are based on geometric features of the person, or other features that are present in the claims.

Various other amendments have been made to the claims as indicated to clarify that these claims do not fall within 35 U.S.C. § 112, sixth paragraph. More particularly, the gerundial phrases in some of the claims have been removed. Additionally, other amendments have been made to the claims to correct antecedent basis, to correct grammar, and/or to make other clarifying corrections.

The appropriate fee to cover payment for the newly added claims is enclosed with this amendment, along with the requisite petition fee. It is believed that no fee is required for a request for extension of time, since the filing of the Petition for Unintentional Abandonment obviates the need to pay an extension fee. However, if the U.S. Patent Office deems that an extension fee is required, the Commissioner is authorized to deduct the appropriate amounts from Deposit Account No. 19-1090. If such a withdrawal is made from the Deposit Account, the Examiner is kindly requested to contact the undersigned attorney so that he can properly notify his accounting department.

Overall, none of the references singly or in any motivated combination disclose, teach, or suggest what is recited in the independent claims. Thus, given the above amendments and accompanying remarks, the independent claims are now in condition for allowance. The dependent claims that depend directly or indirectly on these independent claims are likewise allowable based on at least the same reasons and based on the recitations contained in each dependent claim.

If the undersigned attorney has overlooked a teaching in any of the cited references that is relevant to the allowability of the claims, the Examiner is requested to specifically point out where such teaching may be found. Further, if there are any informalities

Application No. 09/520,479
Reply to Office Action dated December 20, 2002 and
Notice of Abandonment dated June 30, 2003

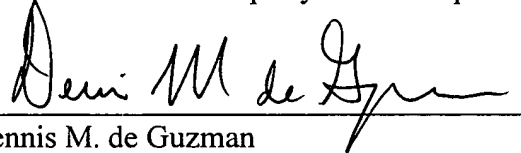
or questions that can be addressed via telephone, the Examiner is encouraged to contact the undersigned attorney at (206) 622-4900.

The Director is authorized to charge any additional fees due by way of this Amendment, or credit any overpayment, to our Deposit Account No. 19-1090.

All of the claims remaining in the application are now clearly allowable. Favorable consideration and a Notice of Allowance are earnestly solicited.

Respectfully submitted,

SEED Intellectual Property Law Group PLLC

A handwritten signature in black ink, appearing to read "Dennis M. de Guzman", is written over a horizontal line.

Dennis M. de Guzman
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DMD:wt

Enclosure:

Postcard

Petition for Revival of an Unintentionally Abandoned Application

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